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EXAMINER

BELL, MELTIN

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,963

Applicant(s)

GIEL ET AL.

Examiner

Meltin Bell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This action is responsive to application **09/851,963** filed **05/10/01**.

Claims 1-23 have been examined.

Information Disclosure Statement

Applicant is respectfully reminded of the ongoing Duty to disclose 37 C.F.R. 1.56 all pertinent information and material pertaining to the patentability of applicant's claimed invention, by submitting in a timely manner PTO-1449, Information Disclosure Statement (IDS) with the filing of applicant's application or thereafter.

Drawings

The United States Patent and Trademark Office of Draftperson's Patent Drawings Review have reviewed the formal drawings.

The drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is required in correcting any errors of which applicant may become aware in the drawings.

The drawings are objected to because:

- They fail to comply with 37 CFR 1.84(p)(5). They include the following reference sign(s) not mentioned in the description: 1406 (near descriptions for items 1404 and 1408 on page 34 [0158-0159]).

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- The 'Develop a management summary' box in FIG.16 is missing a label/item number.
- Item 2210 needs to be closer to the line associating the number with the action box in FIG. 23.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) and make the corrections in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is required in correcting any errors of which applicant may become aware in the specification.

The disclosure is objected to because of the following informalities:

- The analyzer harness on page 8 [0049] is not in FIG. 21. It should be identified as item 806 in FIG. 2.
- The link between analyzer server 800 and enterprise 300 on page 13 [0081] is not visible.
- Auditor 814 should be Auditor 813 on pages 24 [0122], 26 [0127], 27 [0130] and 28 [0134].
- Item 812 referred to on pages 30 [0143] and 32 [0150] is a content expert not a designer.

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Appropriate correction is required.

Claim Objections

Claims 21 is objected to because of the following informalities:

Regarding claim 21:

- it has the format of a dependent claim similar to claims 19 and 20, but should not depend on itself, "The system of claim **21**".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Support for this 35 U.S.C. 112, first paragraph rejections comes from MPEP

2164.07(I)(A):

"As noted in *In re Fouché*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971), if "compositions are in fact useless, appellant's specification cannot have taught how to use them." 439 F.2d at 1243, 169 USPQ at 434. The examiner should make both rejections (i.e., a rejection under 35 U.S.C. 112, first paragraph and a rejection under 35 U.S.C. 101) where the subject matter of a claim has been shown to be nonuseful or inoperative. The 35 U.S.C. 112, first paragraph, rejection should indicate that because the invention as claimed does not have utility, a person skilled in the art would not be able to use the invention as claimed, and as such, the claim is defective under 35 U.S.C. 112, first paragraph."

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The invention as disclosed in claims 1-23 are directed to non-statutory subject matter.

Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility.

Claims 1-11 and 18-23 are not claimed to be practiced on a computer nor are they stored in a computer readable medium. Claims 1-6 and 8-11 are also not in the technological arts. Because the claims are not in the technological arts and are not claimed to be practiced on a computer and/or stored on a computer readable medium, they are not limited to practical applications in the technological arts. Specifically, the claims are methods disclosing ideas abstractly from any particular practical application, such as a program running on a computer and stored in a computer readable medium or memory. On that basis alone, those claims are clearly nonstatutory.

Regardless of whether the claims are in the technological arts, none of them are limited to practical applications in the technological arts. The Office finds that *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994) controls the 35 USC 101 issues on that point for reasons made clear by the Federal Circuit in *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447 (Fed. Cir. 1999). Specifically, the Federal Circuit held that the act of:

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"taking several abstract ideas and manipulating them together adds nothing to the basic equation." *AT&T v. Excel* at 1453 quoting *In re Warmerdam*, 33 F.3d 1354, 1360 (Fed. Cir. 1994).

The Office finds that Applicant's "configuration information" is just such an abstract idea. The Office's position is based upon guidance provided by the Federal Circuit *In re Warmerdam*, as interpreted by *AT&T v. Excel*. This set of precedents is within the same line of cases as the *Alappat-State Street Bank* decisions and is in complete agreement with those decisions. *Warmerdam* is consistent with *State Street's* holding that:

"Today we hold that the *transformation of data, representing **discrete dollar amounts**, by a machine through a series of mathematical calculations into a final share price*, constitutes a practical application of a mathematical algorithm, formula, or calculation because it produces 'a useful, concrete and tangible result' – *a final share price momentarily fixed for recording purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.*" (emphasis added) *State Street Bank* at 1601.

True enough, that case later eliminated the "business method exception" in order to show that business methods were not per se nonstatutory but the court clearly *did not* go so far as to make business methods *per se statutory*. A plain reading of the excerpt above shows that the Court was *very specific* in its definition of the new *practical application*. It would have been much easier for the court to say that "business methods were per se statutory" than it was to define the practical application in the case as "...the transformation of data, **representing discrete dollar amounts**, by a machine through a series of mathematical calculations into a final share price..."

The court was being very specific.

Additionally, the court was also careful to specify that the useful, concrete and tangible result it found was "a final share price momentarily fixed for recording purposes

and even accepted and **relied upon** by regulatory authorities and in subsequent trades.”

Applicant cites no such specific results to define a useful, concrete and tangible result. Neither does Applicant specify the associated practical application with the kind of specificity the Federal Circuit used.

Furthermore, in the case *In re Warmerdam*, the Federal Circuit held that:

“the dispositive issue for assessing compliance with Section 101 in this case is whether the claim is for a process that goes beyond **simply manipulating ‘abstract ideas’ or ‘natural phenomena’**. ...As the Supreme Court has made clear, ‘[a]n idea of itself is not patentable... taking several abstract ideas and manipulating them together adds nothing to the basic equation.’ *In re Warmerdam* 31 USPQ2d at 1759 (emphasis added).

In the present case, the Office finds that Applicant manipulated a set of abstract “results”, “issues” and “reports” for auditing an enterprise and analyzing its configuration information in the **abstract**. Under *Warmerdam*, the result of such manipulations is not statutory.

Since *Warmerdam* is within the *Alappat-State Street Bank* line of cases, it takes the same view of “useful, concrete, and tangible” the Federal Circuit applied in *State Street Bank*. Therefore, under *State Street Bank*, this could not be a “useful, concrete and tangible result”. There is only manipulation of abstract ideas.

The Federal Circuit validated the use of *Warmerdam* in its more recent *AT&T Corp. v. Excel Communications, Inc.* decision. The court noted that:

Finally, the decision in *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994) is not to the contrary. *** The court found that the claimed process did **nothing more than manipulate basic mathematical constructs** and concluded that “taking several abstract ideas and manipulating them together adds nothing to the basic equation”; hence, the court held that the claims were **properly rejected** under Section 101.... Whether one agrees with the court’s conclusion on the facts, **the holding of the case is a straightforward application of the basic principle that mere laws of nature, natural phenomena, and abstract ideas are not within the categories of inventions or discoveries that may be patented under Section 101.**” (emphasis added) *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447, 1453 (Fed. Cir. 1999).

The fact that the invention is merely the manipulation of abstract ideas is indisputable. The objects referred to by Applicant's phrase "configuration information", "results", "issues" and "reports" are simply constructs in the abstract. Consequently, the necessary conclusion under *AT&T*, *State Street* and *Warmerdam*, is straightforward and clear. The claims take several abstract ideas (i.e., "configuration information" in the abstract) and manipulate them together adding nothing to the basic equation. Accordingly, claims 1, 11-12, 18 and 22 are properly rejected along with their dependents 2-10, 13-17, 19-21 and 23.

Also, to Constitutionally interpret the word "process", the Supreme Court has held that:

**** A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state of thing. *** The process requires that *certain things* should be done with *certain substances*, and in a *certain order*, but the tools to be used in doing this may be of secondary consequence." (emphasis added) *Diamond, Commissioner of Patents and Trademarks v. Diehr and Lutton*, 209 USPQ 1, 6 (1981) quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1876).

This Constitutional interpretation of the word "process" is a long-standing one that the Supreme Court requires to be applied in interpreting 35 U.S.C. 101. *Diamond v. Diehr* at 6. Consequently, the use of that interpretation is *Constitutionally required* when we interpret the Federal Court's standard that a "new and useful process" is one that produces a "useful, concrete and tangible result". Cf. *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1600-1601 (Fed. Cir. 1998).

Applicant discloses no "certain substances" that have been "transformed or reduced" in that Applicant's claims disclose no *specific* computer-readable medium, no manipulation of *specific* data representing physical objects or activities (pre-computer activity), nor do they disclose any *specific* independent physical acts being performed

by the invention (post-computer activity). Implementation or utilization of the claimed invention does not include the use of a computer, processor, computer readable medium or memory for storing and executing such programs. The claims merely manipulate abstract ideas in general without limitation to a practical application where "certain substances" are transformed or reduced.

On this basis, claims 1-23 are rejected under 35 U.S.C. 101.

Claims 1-23 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Double Patenting

Claim 11 of this application conflicts with claims 1, 11 and 21 of Application No. 10367048. Claim 16 of this application conflicts with claims 1, 11 and 21 of Application No. 10372475. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14 and 17-23 are rejected under 35 U.S.C. 102(b) as being anticipated by *Kung* U.S. Patent Number 5,295,230 (March 15, 1994).

Regarding claim 1:

Kung teaches,

- collecting information relating to a configuration of the enterprise (FIG. 3; column 12, lines 1-15, "EVENT MANAGER...events where required")
- analyzing the configuration information based on expert knowledge (FIG. 3; column 12, lines 19-25, "NETWORK CONFIGURATION MODULE...network 5 looks like")
- providing a result of the analysis (FIG.3; column 12, lines 19-25, "NETWORK CONFIGURATION MODULE...network 5 looks like")

Regarding claim 2:

Kung further teaches,

- generating a report of the result of the analysis in a format designated by a requesting party (column 13, lines 16-29, "Referring to FIG. 3...the Bulletin Board")

Regarding claim 3:

Kung further teaches,

- delivering the report to the requesting party (column 13, lines 30-32, "Once placed on... Bulletin Board")

Regarding claim 4:

Kung further teaches,

- defining an analyzer based on expert knowledge as an issue with the configuration of the enterprise (column 13, lines 34-43, "A knowledge source... the Network Manager")

Regarding claim 5:

Kung further teaches,

- analyzing the configuration information further includes the step of applying the analyzer to the configuration information to identify whether the issue exists within the enterprise (column 14, lines 20-35, "Of greatest interest... to these goals")

Regarding claim 6:

Kung further teaches,

- the step of capturing the expert knowledge for defining the analyzer (column 2, lines 26-32, "The job of... languages or representations")

Regarding claim 7:

Kung further teaches,

- the method is entirely automated (column 6, lines 64-68, "The Expert System... without operator intervention")

Regarding claim 8:

Kung further teaches,

- the step of creating an action plan to address the issue identified by the analyzer
(column 13, lines 30-68, "Once placed on... of the system")

Regarding claim 9:

Kung further teaches,

- the step of storing the information relating to the configuration of the enterprise
(column 12, lines 37-44, "STATIC KNOWLEDGE BASE... Network Configuration Module")

Regarding claim 10:

Kung further teaches,

- the step of repeating the steps of the method (FIG. 26-27; column 38, lines 22-51,
"The Event Manager... process begins to repeat")

Regarding claim 11:

Kung further teaches,

- collecting information relating to configurations of a plurality of field platforms or nodes
(column 58, lines 30-38, "The Network Configuration Module... to perform diagnostics")
- creating a plurality of analyzers based on expert knowledge, each analyzer
representing one or more issues with one of the plurality of field platforms or nodes
(column 28, lines 10-31, "The hypothesis tree... to be followed")
- applying the plurality of analyzers to the configuration information to determine
whether the issues exists with the plurality of field platforms or nodes (column 41, lines

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64-68, "When it begins analysis... the Expert Informa-"; column 42, lines 1-4, "tion Structure 111...tree are possible")

- storing the issues identified with the plurality of field platforms or nodes (column 19, lines 60-63, "UPDATE ALARM MAP... to knowledge sources")

- creating a plurality of rules based on expert information, each rule representing an issue with the enterprise (column 2, lines 13-18, "Some experienced (expert)... at all locations"; column 12, lines 45-51, "INFERENCE ENGINE 122... Expert Information Structure")

- applying the plurality of rules to the issues stored that exist with respect to the field platforms or nodes (column 12, lines 45-51, "INFERENCE ENGINE 122... Expert Information Structure")

- providing a result of the analysis representing issues within the enterprise (FIG.3; column 12, lines 19-25, "NETWORK CONFIGURATION MODULE... network 5 looks like")

Regarding claim 12:

Kung further teaches,

- collecting variably formatted configuration information from at least one source (FIG. 3; column 12, lines 1-15, "EVENT MANAGER... events where required"; column 28, lines 10-41, "The hypothesis tree... knowledge source table"; column 58, lines 30-38, "The Network Configuration Module... to perform diagnostics")

- analyzing the configuration information using analyzers whose designs are based upon expert knowledge to identify the presence or absence of one or more issues

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associated with the at least one source (column 13, lines 16-29, "Referring to FIG.

3...the Bulletin Board")

- providing as a result of the analysis information defining the presence or absence of the one or more issues in a standard format (column 13, lines 27-34, "In this phase... an active state")

Regarding claim 13:

Kung further teaches,

- each variable format is determined by the ordering of information in the standard output of a computer program collector (column 9, lines 19-24, "The Expert System Programming Environment...to the workstation")

Regarding claim 14:

Kung further teaches,

- the source is a platform or node (FIG. 2, item 5; column 9, lines 24-55 "The ENDS 10...to the minicomputer")

Regarding claim 17:

Kung further teaches,

- the analyzing step includes the step of applying an analyzer to the configuration information to identify whether the issues exist within the source nodes (column 14, lines 20-35, "Of greatest interest...to these goals")

Regarding claim 18:

Kung further teaches,

- a plurality of collectors for collecting configuration information from each of the plurality of sources, the configuration information including a plurality of combinations of data formats, data syntax, and data elements structure (FIG. 2, ITEMS 5, 24, 117, 108 AND 110; FIG. 3; column 12, lines 1-15, "EVENT MANAGER...events where required"; column 28, lines 10-41, "The hypothesis tree...knowledge source table"; column 58, lines 30-38, "The Network Configuration Module...to perform diagnostics")
- a component for analyzing the configuration information for each source of the plurality of sources to identify one or more issues associated with each source (FIG. 2, items 24, 117 and 122; column 13, lines 16-29, "Referring to FIG. 3...the Bulletin Board")
- a component for standardizing the configuration information (FIG.2, items 24, 117, 108 and 110; column 12, lines 37-44, "STATIC KNOWLEDGE BASE...Network Configuration Module")

Regarding claim 19:

Kung further teaches,

- a component for converting the configuration information into a uniform format (FIG.2, items 108 and 110; column 12, lines 19-25, "NETWORK CONFIGURATION MODULE...network 5 looks like")

Regarding claim 20:

Kung further teaches,

- a component for generating a report of the result of the analysis (column 13, lines 30-32, "Once placed on... Bulletin Board")

Regarding claim 21:

Kung further teaches,

- the result may be adapted into one of a plurality of presentation layouts (column 9, lines 51-55, "The database manager...to the minicomputer")

Regarding claim 22:

Kung further teaches,

- a first component for collecting configuration information relating to a plurality of sources (FIG. 2, items 5 and 24; column 14, lines 1-19, 'The "data" referred...data base manager')
- a second component for analyzing the configuration information based on expert knowledge to identify an issue associated within each source of the plurality of sources (FIG. 2, items 108, 109 and 117; column 12, lines 1-15, "EVENT MANAGER...events where required"; column 11, lines)
- a third component for providing results of the analysis of each source (FIG. 2, item 120; column 13, lines 22-34, "These data are...an active state")

Regarding claim 23:

Kung further teaches,

- a fourth component for generating one of a plurality of reports with the results (FIG. 2, item 122; column 37, lines 66-68, "Fourth, 706 invokes...the problems. Fifth"; column 38, lines 1-17, '708 then invokes...user selects "Exit"')

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Office presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Office to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kung* U.S. Patent Number 5,295,230 (March 15, 1994) in view of *Miller et al* (December 2000) and further in view of *Atanasova et al* (July 2000).

Regarding claim 15:

Kung teaches,

- the result may be adapted into one of a plurality of presentation layouts (column 9, lines 51-55, "The database manager...to the minicomputer")

However, *Kung* doesn't explicitly teach presentation layout results with XML as the format while *Miller et al* teaches,

- the standard format XML (p. 1849, Abstract, sentences 2-3, "Combining this with...information technology components"; p. 1850, section 3, paragraph 2, "Each program has...open format (e.g. XML)")

Motivation – The portions of the claimed method for using XML while auditing automatically a configuration of at least one source within an enterprise would have been a highly desirable feature in this art for

- locating and diagnosing network problems (*Kung*, column 2, lines 5-12, "In a typical...isolate network faults")
- simplifying program and enterprise information system development (*Miller et al*, section 4, paragraph 6, "EJB provides many...Web-Based Simulation systems")

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to combine *Kung* with *Miller et al* to obtain the invention specified in claim 15, XML as the standard in automatic enterprise auditing. The modification

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would have been obvious because one of ordinary skill in the art would have been motivated to facilitate problem resolution within the enterprise.

Regarding claim 16:

Kung teaches,

- the result may be adapted into one of a plurality of presentation layouts (column 9, lines 51-55, "The database manager...to the minicomputer")

However, *Kung* doesn't explicitly teach XML for presenting results in databases while *Miller et al* further teaches,

- transferring the XML analysis result into a database (p. 1853, section 5, paragraph 8, sentences 5-7, "After the model...for searching purposes")

However, *Kung* as well as *Miller et al* don't explicitly teach XML for controlling database result reporting while *Atanasova et al* teaches,

- using the database to control the assembly of reports (p. 366, section 4, paragraph 7-8, "XML Agents [3]...number of environments")

Motivation – The portions of the claimed method for using an XML database to control auditing automatically a configuration of at least one source within an enterprise would have been a highly desirable feature in this art for

- making the best knowledge base available at all times and in all locations (*Kung*, column 2, lines 15-23, "It is desirable...manage bigger networks")
- maximizing flexibility in network dynamics (*Miller et al*, Abstract, sentence 5, "Components will need...of interacting components")

- optimizing control of the enterprise while hiding its complexity (*Atanasova et al*, section 4, paragraph 2, sentence 2-4, "Agent base approach...underlying information sources")

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to combine *Kung* with *Miller et. al.* and *Atanasova et al* to obtain the invention specified in claim 16, an XML database in automatic enterprise auditing.

The modification would have been obvious because one of ordinary skill in the art would have been motivated to benefit non-experts by optimizing expert control and maximizing flexibility in the implementation of a fully accessible distributed database system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- C.Y. Kung; U.S. Patent Number 5,295,230
- M. Desgrousilliers, J.S. Prugsanapan, G.H. Henderson; U.S. Patent Number 5,715,373
- J.C. Weber; U.S. Patent Number 5,812,668
- J.A. Miller, A.F. Seila, J. Tao; "Web-based and Java-based simulation: Finding a substrate for federated components on the web"; Proceedings of the 32nd conference on Winter simulation; December 2000; pp 1849-1854
- T. Atanasova, H.-J. Nern, M. Hamalainen, H.N. Eldin; "Distributed heterogeneous knowledge data base for control system design: multiagent development and support";

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Proceedings of the 2000 IEEE International Symposium on Intelligent Control; 17-19
July 2000; pp 363 -368

- *D. Bühler, W. Kűchlin*; "Remote fieldbus system management with Java and XML";
Proceedings of the 2000 IEEE International Symposium on Industrial Electronics; Vol. 1;
ISIE 2000; 4-8 Dec. 2000; pp 1 -6

- *M. Bichler , A. Segev , J. L. Zhao*; "Component-based e-commerce: assessment of
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December 1998; pp 7-14

Any inquiry concerning this communication or earlier communications from the
Office should be directed to Meltin Bell whose telephone number is 703-305-0362.

This Examiner can normally be reached on Mon - Fri 7:30 am - 4:30 pm.

If attempts to reach this Examiner by telephone are unsuccessful, his supervisor,
Anil Khatri, can be reached on 703-305-0282. The fax phone number for the
organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is 703-305-
3900.

MB

Ramesh Patel
RAMESH PATEL
PRIMARY EXAMINER 11/17/03
For Anil Khatri